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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,883	03/06/2002	Yasuyuki Yoshimura	423-P-024A	7866

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/091,883		YOSHIMURA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Callie E. Shosho		1714	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 10/28/02. It is noted that the statutory double patenting rejection of record ("same invention") is overcome in light of the cancellation of claims 2, 4, 6, 8, 10, and 14 in copending 09/523,619.

The new grounds of rejection as set forth in paragraphs 2-5 and 13 below are necessitated by applicants' amendment and thus, the following rejection is final.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 22-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 22-23, 29, 33, 37, 40, 42, and 44 have been amended to recite that the metal coated inorganic pigment has a "reflecting surface". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase "reflecting surface" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and

MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

Further, while the present specification does disclose that the inorganic pigment is coated with metal and discloses that the inorganic pigments include aluminum which would necessarily provide a reflecting surface, there is no support for any type of reflecting surface. That is, reflecting surfaces can include those made from materials other than metals or metal oxides such as barium sulfate, silicates, polymeric beads, etc. Evidence to support this position is found, for instance, in col. 2, lines 27-33 of Bishop (U.S. 4,606,992). Applicants attempt to broaden the scope of the claims on the basis of a few embodiments of metal coated inorganic pigments in the specification is without support and clearly represents new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 22-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22-23, 29, 33, 40, 42, and 44 have been amended to recite that the metal coated inorganic pigment has a "layer of metal". The scope of the claims is confusing because it is not clear what is meant by "metal". As defined on page 2, lines 20-22 of the present specification, metal includes both metal and metal oxide. Does the "layer of metal" include both metal and metal oxide?

The scope of the claims is also confusing because it is not clear what "layer of metal" means. Does this refer to the coating on the pigment, to the pigment itself, or to an additional layer of metal? Clarification is requested.

**Claim Rejections - 35 USC § 102**

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 22-27, 29-35, and 37-44 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10077438.

The rejection is adequately set forth in paragraph 6 of the office action mailed 4/19/02, Paper No. 3, and is incorporated here by reference.

8. Claims 22-26, 29-30, 33, 35, 37-38, 40, 42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 7118592.

The rejection is adequately set forth in paragraph 7 of the office action mailed 4/19/02, Paper No. 3, and is incorporated here by reference.

9. Claims 22-27, 29-30, 32, 38, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 600205.

The rejection is adequately set forth in paragraph 8 of the office action mailed 4/19/02, Paper No. 3, and is incorporated here by reference.

**Claim Rejections - 35 USC § 103**

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10077438, JP 7118592, and EP 600205 any of which in view of Okuda et al. (U.S. 5,510,397).

The rejection is adequately set forth in paragraph 11 of the office action mailed 4/19/02, Paper No. 3, and is incorporated here by reference.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10077438 or JP 7118592 either of which in view of Linton (U.S. 3,087,828).

The rejection is adequately set forth in paragraph 12 of the office action mailed 4/19/02, Paper No. 3, and is incorporated here by reference.

13. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10077438, JP 7118592, or EP 600205 any of which in view of Schmidt et al. (U.S. 5,277,711).

The disclosures with respect to JP 10077438, JP 7118592, and EP 600205 in paragraphs 7, 8, and 9, respectively, are incorporated here by reference.

The difference between JP 10077438, JP 7118592, or EP 600205 and the present claimed invention is the requirement in the claim of specific type of metal-coated inorganic pigment.

Each of JP 10077438, JP 7118592, and EP 600205 disclose ink comprising mica coated with titanium oxide or iron oxide.

Schmidt et al., which is drawn to pigments, disclose the equivalence and interchangeability of iron oxide coated mica with iron oxide coated aluminum as effect pigments whose color varies with angle of observation and are suitable for use in inks (col.1, lines 4-14 and 37-41).

In light of the disclosure of Schmidt et al., it therefore would have been obvious to one of ordinary skill in the art to use iron oxide coated aluminum in the ink of either JP 10077438, JP 7118592, or EP 600205 in order to produce ink whose color varies with angle of observation, and thereby arrive at the claimed invention.

#### **Response to Arguments**

14. Applicants arguments regarding JP 09628270 have been considered but they are moot in view of the discontinuation of this reference against the present claims.

15. Applicants' arguments filed 10/29/02 have been fully considered but, with the exception of arguments relating to JP 09628270, they are not persuasive.

Specifically, applicants argue that:

(a) JP 10077438, JP 7118592, and EP 600205 do not disclose glittering inks as presently claimed.

(b) JP 10077438 does not disclose ink with viscosity as presently claimed.

(c) Linton do not disclose pigment as presently claimed.

With respect to argument (a), JP 10077438, JP 7118592, and EP 600205 each disclose ink which contains mica coated with iron oxide or titanium oxide. Applicants argue, as set forth on page 7 of the amendment, that since mica coated with metal oxide does not contain a reflecting surface or layer of metal, it cannot glitter or produce glittering ink.

However, firstly, it is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by the applicant regarding the differences between the metal coated inorganic pigments presently claimed and those disclosed by the references of record must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

Secondly, it is noted that in light of the confusion with respect to the phrase “layer of metal” (see paragraph 5 above), JP 10077438, JP 7118592, and EP 600205 disclosures of mica coated with iron oxide or titanium oxide meets the limitation of the present claims with respect to “layer of metal” given that “layer of metal” clearly encompasses “layer of metal oxide”.

Thirdly, applicants argument that mica coated with iron oxide or titanium oxide do not glitter and cannot produce glittering ink is not understood in light of page 5, lines 7 and 15-16 of the present specification which discloses that mica coated with iron oxide and mica coated with titanium oxide are pigments within the scope of the present invention and do produce glittering inks. Thus, given that the present specification discloses that mica coated with iron oxide and



mica coated with titanium oxide do produce glittering inks, it is not clear why applicants argue that these pigments do not produce glittering inks. Clarification is requested.

Further, on page 7 as well as in the paragraph bridging pages 8-9 of the amendment filed 10/29/02, applicants argue that mica coated with metal oxide cannot function as glittering pigment given that incident light hardly reflects on a surface of metal oxide. However, the bottom of page 1 of "Handprint: Interference Paints" (article attached by applicants to the amendment) discloses that metal oxide is highly refractive and reflective. From the article, it appears that metal oxide surface does reflect light. Thus, it is not clear why applicants argue that metal oxide does not reflect light.

Additionally, applicants' arguments regarding mica coated with metal oxide are confusing in light of the Figure attached to the amendment, which compares metal oxide coated metal, metal coated metal oxide, and mica coated with metal oxide. From the Figure, it appears that mica coated with metal oxide reflects light as do metal oxide coated metal and metal coated metal oxide. Applicants note that this is not a metal reflection. Do only certain types of light reflection produce glittering inks? Further, although it is clear that light is refracted from the surface of the metal oxide through the inner portion of the particles and permeates for the mica coated with metal oxide, from the Figure it is clear that light is also reflected from the metal oxide surface. Thus, it is not clear what the difference is between the three pigments in the Figure given that both metal and metal oxide surfaces reflect light. Clarification is requested.

In light of the above, JP 10077438, JP 7118592, and EP 600205 remain relevant references against the present claims.

With respect to argument (b), applicants argue that it is not clear if the ink of JP 10077438 possesses viscosity which falls within the range of 1000 to 10000 mPas as presently claimed especially given that JP 10077438 do not disclose ink identical to that presently claimed.

However, as can be seen from Table 2 of JP 10077438, the ink exhibits pseudoplastic behavior, i.e. as the shear rate decreases, the viscosity increases. Given this behavior, it is clear that the viscosity at 0.5 rpm will be greater than viscosity at 1 rpm which is 1000 mPas or greater for all the inks disclosed in the Table. In light of this, and absent clear and convincing evidence to the contrary, it is the examiner's position that JP 10077438 do disclose viscosity as presently claimed. Applicants also argue that ink of JP 10077438 is not identical to that presently claimed, however, given that JP 10077438 discloses ink comprising water, solvent, water-soluble resin, colorant, and mica coated with iron oxide or titanium oxide which, given that "layer of metal" as presently claimed clearly encompasses "layer of metal oxide", meets the claimed limitation of metal coated inorganic pigment which has layer of metal, it is clear that JP 10077438 do disclose ink as presently claimed.

With respect to argument (c), it is agreed that Linton do disclose mica coated with metal oxide. However, it is the examiner's position that this does meet the claimed limitation of metal coated inorganic pigment which has layer of metal given that the disclosure of "layer of metal" clearly encompasses "layer of metal oxide" which is disclosed by Linton.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

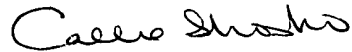
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho

Examiner

Art Unit 1714

CS

1/13/02